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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1940.

No. 518.

OBEAR-NESTER GLASS COMPANY,
Plaintiff-Petitioner,

v.

WALGREEN DRUG STORES, INC.,
Defendant-Respondent,

and

CORNING GLASS WORKS,
Intervenor-Respondent.

PETITION FOR REHEARING OF A PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

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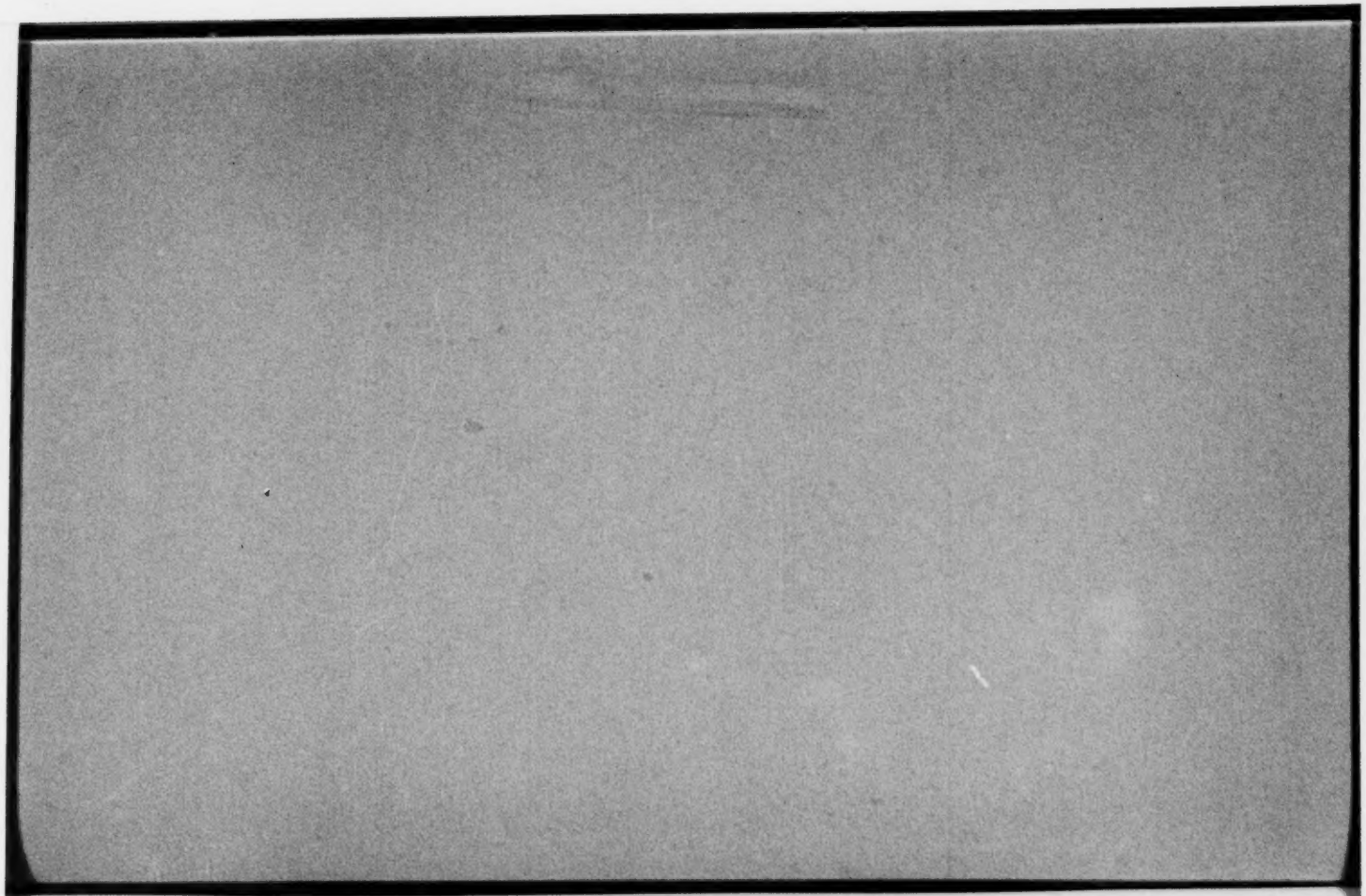
St. Louis, Missouri,
December 9, 1940.

St. Louis Law Printing Co., 415 North Eighth Street. CEntral 4477.



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To the Honorable The Chief Justice and the Associate Justices of the Supreme Court of the United States:

Manifestly, in our petition for writ of certiorari to the Eighth Circuit Court of Appeals and in the supporting briefs, we have failed to bring out those errors and inconsistencies of law in the decision of the Eighth Circuit Court of Appeals which are prejudicial to the petitioner, to all other registered trade-mark owners, and to the public, in the Eighth Circuit, and elsewhere, and which appear to so urgently require the consideration of this Court. We do not know why our petition for writ of certiorari was denied, but presumably we did not get across to the Court the grave fundamental points of federal trade-mark law and the other points which are involved here.

We earnestly urge this Court to carefully consider the following few pages, for we sincerely believe that the essence thereof will focus the points involved to present to this Court the inequitable and hopelessly confusing situations which the decision petitioned from creates. And we hasten to assure the Court that we are not in the position of one who fails to see the forest because he is standing so close to the trees.

Certainly our petition for writ of certiorari to the Eighth Circuit Court of Appeals is not purely altruistic, but neither is it solely selfish. We are not asking this Court only to rule that the trade-marks involved are confusingly similar and that the goods on which the marks are used are of the same descriptive properties. By our petition, fundamental points of federal trade-mark law are submitted, *fundamental points upon which the ultimate fact rulings of the Eighth Circuit Court of Appeals are based.* Therefore, there are involved, *first,* the legal questions vitally important to the public, to all other owners of registered trade-marks, and to the petitioner, and, *second,* the fact questions of more limited importance to the parties.

Mere Academic Questions Are Not Involved.

And neither are the questions presented by the petitioner merely academic in their relation to the ultimate outcome of the present case. A clarification of the concerned rules of trade-mark law holding the law of the nine other circuits to be ruling authority must necessarily result in a reversal of the *fact conclusions* of the Eighth Circuit Court of Appeals by that tribunal itself.

It must be borne in mind that the Eighth Circuit Court of Appeals *specifically limited* the petitioner's *registration and right to redress to prescription bottles which the respondent Corning does not make!* Immediately, under such a ruling, the petitioner has no case. With this unnatural

restriction justly removed, and only this Court can remove it, then the goods and marks involved must and will be viewed from a different and the correct angle.

Hence, it is plain to see that the petitioner seeks a reversal as an inevitable result of this Court's definition of the federal trade-mark law involved.

Being a Trade-Mark Infringement Suit, the Involved Subject Matter Can Never Be Presented to This Court at a Later Date.

Before again pointing out the errors of law which we so earnestly believe should be ruled upon by this Court, attention is directed to the fact that unless this Court grants the petition, the petitioner, as a practical proposition, is forever barred from presenting the questions involved to this Court. There exists no *real* possibility of obtaining a conflicting decision from another Circuit Court of Appeals on the same subject matter, for this is a trade-mark infringement suit and not a patent suit. The petitioner cannot bring suit against another infringer using the mark employed by the respondent Corning since none exists, and, of course, it cannot institute proceedings against the respondents in another Circuit. We know of no other infringing mark.

This Court has reviewed very few trade-mark infringement decisions, a main reason being, manifestly, that there *is no real possibility* of obtaining conflicting decisions from different Circuit Courts of Appeals in regard to a plaintiff's trade-mark, as there is in respect to a plaintiff's patent. The validity of the trade-mark is seldom in serious debate. Certainly, this limitation in trade-mark suits should be given grave consideration by this Court, and, in view of its existence, more serious consideration should be accorded accepting the questions here presented.

On May 31, 1938, this Court granted a writ of certiorari

to the Sixth Circuit Court of Appeals in the case of *Schriber-Schroth Co. v. Cleveland Trust Co. and Chrysler,* 305 U. S. 47, 83 L. ed. 34, upon a *second petition for rehearing* filed by the petitioner in which the main and really *only* point advanced was the fact that the location of by far the greater part of the automotive industry within the Sixth Circuit established such a favorable situation for the plaintiff that as a practical matter there would be no suit on the validated patents outside the Sixth Circuit, and, therefore, no opportunity for a decision upon the validity of the patents in another circuit. There were involved both the personal interest of the petitioner and the interest of the public in regard to the patents at issue.

Surely, more fundamental legal questions of concern to thousands of *directly* interested parties are involved in the present trade-mark controversy, and this, also, is one that will never be reviewed by this Court unless the petition is granted *now*. As far as the legal questions are concerned, there is no reason to expect this Court to accept the next petition from the Eighth Circuit if the present one is refused. As it did in the *Schriber-Schroth* case, so here the Court should consider the fact that if it refuses to grant the petition it closes the door of review permanently to the petitioner, and, in effect, to all other owners of registered trade-marks and to the public.

We urge, therefore, that since there is no possibility of obtaining conflicting decisions of Circuit Courts of Appeals, this Court, as it did in the *Schriber-Schroth* case, should give the fact great weight, and again consider the conflicting federal questions presented by our Petition with a view to allowing the writ. Clearly, the petitioner is in no weaker position than was the defendant-petitioner in the *Schriber-Schroth* case!

The Disclaimer Ruling, Which Violates Stare Decisis and Does Violence to the Trade-Mark Acts.

The Eighth Circuit Court of Appeals has established for the Eighth Circuit the rule that the description of particular goods in a trade-mark registration as required by the May 4, 1906, amendment to the *Federal Trade-mark Act of 1905* is a *disclaimer of all other goods not specifically enumerated*, which is contrary to the words and clear intent of the Acts, is contrary to the accepted law of the other nine circuits that the requirement is merely procedural, and is contrary to the rule obtaining theretofore in the Eighth Circuit.

There is involved here, therefore, a conflict on a fundamental point of trade-mark law between the Eighth Circuit and the nine other circuits, a point involving interpretation of a federal statute. As we have emphasized above, there can never exist a *direct* conflict between circuits *on this case itself*, since there is no possibility of a readjudication of the present controversy in whole or in part.

We reiterate that there is nothing unique about the 1927 registration of REX (R. 69). On pages 5 through 8 of the "Petitioner's Reply to Answer of Respondents" this fact is conclusively clarified. It is just like any other registration under the 1905 Act, being drawn in conformity with the recommended form provided by the Patent Office. Again we urge the Court to compare the petitioner's 1927 Registration with *any* other registration under the 1905 Act as amended. There is no difference in form.

No, there is nothing unique about the petitioner's 1927 Registration, nor does the Eighth Circuit Court of Appeals say there is. The respondents advance this peculiar argument in an effort to make this Court believe that the decision of the Eighth Circuit Court of Appeals applies only to the present case. Surely, this Court can see that the disclaimer ruling is not local, but is general, particularly after

comparing the petitioner's 1927 Registration with any other 1905 registration and reading the words of the court.

For emphasis we requote from the decision of the Eighth Circuit Court of Appeals, which, in respect to the disclaimer doctrine enunciated, said (R. 1212):

> "* * * The registered trade-mark is limited by its claim, and the applicant is concluded by his statement made a part of his application."

and (R. 1219):

> "So here, the defendant could not certainly, in face of the declared purpose of plaintiff to limit its trade-mark 'Rex' to prescription bottles, and its conduct in limiting its products to such bottles, have anticipated that it would begin to manufacture and sell nursing bottles." (Emphasis supplied.)

How can the petitioner, or any other registrant, be guilty of a "declared purpose * * * to limit its trade-mark" when all that has been done is to comply with the manifest procedural requirements of the Trade-Mark Act as amended, the amending act of May, 1906, reading in part:

> "On a single application * * * the trade-mark may be registered * * * for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular description of goods be stated,"

and rule 22 (b), which reads in part:

> "* * * the class of merchandise (according to the official classification), and the particular description of goods comprised in such class upon which the trade-mark has actually been used, * * *"?

Such a ruling does violence to the manifest words and intent of the Trade-Mark Act of 1905 as amended.

Yet the Eighth Circuit Court of Appeals by its above-

quoted language has declared that in the Eighth Circuit the particular description of goods now is a *disclaimer* of *all* other goods not specifically mentioned. Great confusion and grave injustice will flow from the decision because a registrant will get a procedural interpretation of its registration *in all circuits save the Eighth*, yet in the Eighth Circuit it will have its registration restricted in accordance with the disclaimer rule of the present case. Numerous inequitable situations are easy to conceive.

This Court granted a writ of certiorari in the case of *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U. S. 315, 83 L. ed. 195, one of the *very* few trade-mark cases accepted in recent years, *to interpret the Trade-Mark Act of 1920*, stating (p. 322):

> "* * * We granted certiorari on account of the importance in trade-mark law of the issues of the descriptive character of the mark and the effect of its acquired meaning under the Trade-Mark Act of 1920. 305 U. S. 580, post, 365, 59 S. Ct. 64."

Certainly, the Trade-Mark Act of 1905, as amended, is *by far* the more important of the two acts. And, in the present case, a *destructive* interpretation has been grafted on the Trade-Mark Act of 1905, as amended, which the Seventh Circuit Court of Appeals had *not* done to the Trade-Mark Act of 1920! We submit that the acceptance of the *Nu-Enamel* case is conclusive that the present case should also be accepted.

In accordance with the words and clear intent of the Trade-Mark Act of 1905, as amended, the nine other Circuit Courts of Appeals have always accepted the particular description of goods in a trade-mark registration as procedural. We have found no contrary ruling, and the respondents have cited none. For thirty-four years there

has not been an adverse ripple in the great lake of decisions until now. Several of the well-known cases exemplifying the accepted procedural rule are:

Rosenberg Bros. & Co. v. Elliott, 7 F. (2d) 962 (C. C. A. 3);
Mantle Lamp Co. v. Aladdin Mfg. Co., 78 F. (2d) 426 (C. C. A. 7);
Waterman Co. v. Gordon, 72 F. (2d) 272 (C. C. A. 2);
Duro Co. v. Duro Co., 27 F. (2d) 339 (C. C. A. 3).

By its disclaimer ruling the Eighth Circuit Court of Appeals has flatly contradicted *stare decisis*, and is in *direct conflict with the nine other Circuit Courts of Appeals* on the point.

Manifestly, only this Court can correctly interpret the Trade-Mark Act of 1905, as amended, for the Eighth Circuit Court of Appeals, to place the present decision in accord with all others, so that trade-mark infringement plaintiffs in the Eighth Circuit may have the same rights as they would have in any of the other circuits.

Refusal to Apply the Expansion of Business Doctrine to Registered Trade-Marks.

The Eighth Circuit Court of Appeals refused to apply to technical registered trade-marks the doctrine of expansion of business to related products. To requote, that court said (R. 1218):

> "It is urged by plaintiff that under the doctrine of expansion of business it is entitled to an unhampered use of its trade-mark 'Rex' on products normally considered as of its manufacture. As has already been pointed out, plaintiff's suit is based upon an alleged *infringement of a registered trade-mark*. The bill contains no averments of unfair competition, nor, indeed,

> is it alleged that purchasers are deceived into buying the products of defendant in the belief that they come from plaintiff. *It is doubtful whether the doctrine of expansion of trade is applicable in a case of alleged infringement of a technical registered trade-mark. Rosenberg Bros. & Co. v. Elliott,* 3 Cir., 77 F. (2d) 692." (Emphasis added.)

Again we point out that the ruling is *not* supported by the *Rosenberg* case, and that the Eighth Circuit Court of Appeals misapprehended the opinion, with which the respondents *now* agree, as is evidenced by their failure to challenge this position, or even mention the *Rosenberg* case, in their Answer to our Petition and Brief. We refrain from quoting at length from the *Rosenberg* case, but request the Court to read the excerpts on pages 26 and 27 of our Petition and Brief and to read the case, for it *specifically analyzes the expansion of business doctrine in connection with technical registered trade-marks and applies it!*

The ruling of the Eighth Circuit Court of Appeals is in direct conflict with the decisions of the nine other Circuit Courts of Appeals. We have found no decision, and the respondents have cited none, in which the expansion of business doctrine has been refused *solely because the mark sued on was a technical registered trade-mark!* Manifestly, the doctrine has been refused where the facts did not support it, but *never before,* in our knowledge, because there was involved a technical registered trade-mark.

In addition to the *Rosenberg* case, other decisions accepting the expansion of business doctrine and establishing *stare decisis* are:

> *Aunt Jemima Mills Co. v. Rigney & Co.,* 247 F. 407 (C. C. A. 2);

Landers Frary & Clark Co. v. Universal Cooler Corp., 85 F. (2d) 46 (C. C. A. 2);
Pocono Rubber Cloth Co. v. Livingstone, Inc., 79 F. (2d) 446 (C. C. A. 3);
Mantle Lamp Co. v. Aladdin Mfg. Co., 78 F. (2d) 426 (C. C. A. 7);
Cf. Hydraulic Press Brick Co. v. Stevens, 15 F. (2d) 312 (C. C. A. 5);
Cluett, Peabody & Co. v. Wright, 46 F. (2d) 711 (C. C. P. A.);
Simplex Electric Heating Co. v. Gold Car Co., 43 App. D. C. 28.

Again we inquire, what basis has the new discriminating expansion of business rule of the Eighth Circuit Court of Appeals? No plausible *reason* can be advanced for thus depriving a technical registered trade-mark of this valuable accepted test, and the Eighth Circuit Court of Appeals gave none, merely citing the *Rosenberg* case, which, contrary to that court's belief, *actually supports the application of the rule to a technical registered trade-mark case*, as we have so clearly demonstrated in our Petition and Brief, pages 26-28.

Manifestly, therefore, only this Court can give to trade-mark plaintiffs in the Eighth Circuit the right to have the expansion of business doctrine applied to their technically registered trade-marks.

Disclaimer and Refusal of Expansion of Business Doctrine Combine to Emasculate a Registered Trade-Mark.

By the rulings of the Eighth Circuit Court of Appeals, a registered trade-mark in the Eighth Circuit is narrowed to such a great extent that registration becomes a definite liability. In the Eighth Circuit, a registrant is now placed at a distinct disadvantage; an owner of an unregistered trade-mark is in a position superior to that of such reg-

istrant. Surely the Trade-Mark Act of 1905 as amended was not enacted to *defeat* trade-mark rights!

Witness the results as exemplified by the present case. In the petitioner's 1927 registration the particular goods clause enumerates prescription bottles. By the Eighth Circuit Court of Appeal's rulings, the petitioner has *disclaimed* all other goods, *even other kinds of bottles,* and is precluded from the application of the expansion of business doctrine because the trade-mark is registered! If the petitioner's mark were *not* registered, then there would be no disclaimer and the expansion of business doctrine would attach. The petitioner's registered trade-mark was held *not* to extend to *other glass bottles* manufactured and sold by the respondents. Hence, the present case is not what *might* happen; it is what has *already* happened under the aforesaid rulings!

How is a registrant in the Eighth Circuit ever going to secure the benefits of *Sections 96 and 99 of the U. S. Code, Title 15* (Our Petition and Brief, pages 14 and 15), unless the goods sold are identical? The rulings of the Eighth Circuit Court of Appeals strike "merchandise of substantially the same descriptive properties" from remedial section 96. In the Eighth Circuit, the owner of the registered trade-mark "Oomp" for canned beans cannot stop use by another of the same mark "Oomp" on canned beets, where the registration enumerates only "canned beans" as the particular description of goods! And a third party could use "Oomp" on canned corn. Confusion would flow unchecked.

Then consider the case where the Dee Corporation owns the registration of the trade-mark "Oomp" in which the particular designation of goods is canned beans, and sells canned beans so marked throughout the United States. In

St. Louis, Missouri, the Eee Corporation subsequently sells canned beets under the mark "Oomp"; and about the same time the Fee Corporation begins to sell canned corn in East St. Louis, Illinois, bearing "Oomp" as the trade-mark. The inevitable results of registered trade-mark infringement suits by the Dee Corporation conclusively prove the legal conflict and confusion that now exist since the decision petitioned from, for in East St. Louis, Illinois (Seventh Circuit), the Dee Corporation *can* successfully enjoin the use of "Oomp" on canned corn by the Fee Corporation (*Mantle Lamp Co. v. Aladdin Mfg. Co.*, 78 F. [2d] 426 [C. C. A. 7], and other cases), yet in St. Louis, Missouri (Eighth Circuit), the Dee Corporation *cannot* enjoin the use of "Oomp" on canned beets by the Eee Corporation (*Corning et al. v. Obear-Nester*, 113 F. [2d] 956 [C. C. A. 8])!

Such examples of legal conflict and confusion can be multiplied, but surely the foregoing suffice.

Maybe this Court will say that the Dee Corporation's predicament can be considered when it arises, but we answer that the case *has* arisen, and that the role of the Dee Corporation is filled by the petitioner, for the petitioner stands barred by the rulings of the Eighth Circuit Court of Appeals and the confusing conflict *now exists*. In the Eighth Circuit the petitioner is restricted by the new rules of the Eighth Circuit Court of Appeals, yet in the Seventh Circuit no such restrictions exist. The conflict of the law is very much with us; as a practical fact, however, there is no defendant in the Seventh Circuit, or any of the other circuits, so that a second actual suit cannot materialize, and hence we turn to the *Schriber-Schroth* case, *supra*, where this Court accepted a patent case because as a practical matter there could be no actual conflicting decisions.

Only this Court can reestablish in the Eighth Circuit

the sound rules which obtained prior to the present decision, and which obtain in the nine other circuits.

The Interests of All Owners of Registered Trade-Marks and of the Public Are Involved Here.

The interests of *all* owners of registered trade-marks and of the public are manifestly directly affected by the aforediscussed rulings of the Eighth Circuit Court of Appeals.

No registration enumerates *all* of the goods of a particular class. Heretofore registrants have relied upon the *procedural* rule of designation of particular goods and on the expansion of business doctrine to give due protective latitude to their registered marks, rules which attach in the nine other circuits, but which are no longer applicable in the Eighth Circuit. And as a practical matter, registered trade-mark owners are powerless to repair the vulnerable hole which the present law in the Eighth Circuit has made in the protective coat.

A single simple illustration suffices to show the gross inequities which will inevitably arise. The A. B. C. Corporation uses the registered trade-mark "Tops" on coffee, canned tomatoes and canned corn, and owns the registration certificate for "Tops," in which the "particular description of goods" is stated as coffee, canned tomatoes and canned corn. Sales of the products have been made throughout the United States, including the states comprising the Eighth Circuit, for a number of years, the excellence of the products having created a valuable good will. In 1941 into the food field comes the X. Y. Z. Corporation, which, in good faith, sells in Missouri and Iowa canned beans, canned peas and canned beets under the

mark "Tops," there being no simulation of the A. B. C. Corporation's label.

Now, then, what recourse has the A. B. C. Corporation for trade-mark infringement on its registered trade-mark "Tops" under *U. S. Code, Title 15, Sections 96 and 99* (Petition and Brief, pages 14 and 15)? The answer is, None! The X. Y. Z. Corporation does business *only* in Missouri and Iowa, both in the Eighth Circuit. And in the Eighth Circuit the A. B. C. Corporation has *disclaimed all goods except coffee, canned tomatoes and canned corn!* Also, the expansion of business doctrine does not apply to registered trade-marks in the Eighth Circuit. Therefore, the X. Y. Z. Corporation can continue to sell its aforesaid goods in Missouri and Iowa with impunity, and the A. B. C. Corporation is powerless to exert the statutory rights which attach in the nine other circuits!

The final result is complete destruction of the registered trade-mark in the Eighth Circuit, since other companies will use "Tops" for *other* goods of the same descriptive properties as those of the A. B. C. Corporation, such as canned asparagus, canned squash, etc., for the Eighth Circuit Court of Appeals has reduced "same class" and "same descriptive properties" to "*same article,*" thereby in practical effect destroying *all* protective latitude of a registered trade-mark. How can the mark survive?

Under such circumstances which will inevitably arise from the rulings of the Eighth Circuit Court of Appeals, the purchasing public will be utterly confused. It will be sold substitutes for old line trade-mark products, intentionally and unintentionally. There is no escape from this unhappy result as long as the rulings of the Eighth Circuit Court of Appeals remain in effect.

Probably this Court will say that it does not treat future cases, but to this we reply that what we have pointed out as impending for *all* registered trade-mark owners *has happened to the petitioner as the first sufferer under the new rules in the Eighth Circuit!*

And maybe this Court will say that such harsh cases can be ruled upon by it when they arise, but to this we reply that the *present case* is a harsh one, and ask how another registered trade-mark infringement suit of a similar nature can reach this Court when the present case is denied a hearing. Our hypothetical set of facts but conclusively demonstrates the absurd inequities of the new rules of the Eighth Circuit, and forecasts coming events.

Only this Court can disperse the dark clouds under which the registered trade-marks of all owners now labor in the Eighth Circuit, and, therefore, it should grant the petitioned writ so as to clarify the situation *now* before other owners suffer the inevitable consequences of the new rules and the public is completely confused.

The Fact Questions.

It seems unnecessary to go far into the fact questions again, for if this Court will not grant the petition upon the important conflicting legal rulings and statutory interpretations of the Eighth Circuit Court of Appeals, then it certainly will not grant it upon a mere fact basis. On pages 30-35 of our Petition and Brief the fact situation and related matter are carefully discussed.

In the first part of this petition for rehearing we point out that a decision by this Court reversing the new rules of the Eighth Circuit Court of Appeals to align the law of the Eighth Circuit with the law of the nine other cir-

cuits must necessarily result in a reversal of the fact rulings by the Eighth Circuit Court of Appeals itself. We reiterate that manifest necessity. And this Court can itself readily reestablish the proper fact rulings, in which case it would be in accord with the majority of tribunals which have heretofore ruled upon the questions, for both the Examiner of Interferences and the District Court have held the marks of the parties confusingly similar and the goods to which such marks are applied to be of the same descriptive properties.

Further, surely this Court will not close its eyes to the fact that two out of the three tribunals have ruled favorably to the petitioner on *all* points, and that the dissenting tribunal made no effort or pretense in its decision to comply with the established law that the "Findings of fact (of a lower court) shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses" [*Rule 52 (a)* of the *Rules of Civil Procedure*].

Conclusion.

The tremendous impact of the rulings of the Eighth Circuit Court of Appeals is manifest when, in the light of the foregoing, it is fully appreciated that literally millions of kinds of articles bearing a trade-mark, registered or potentially registerable, are sold in the Eighth Circuit today. *And* under the rulings of the Eighth Circuit Court of Appeals, *every kind of article* can bear the *same mark* and be manufactured and sold by a different company!

In view of the manifest importance to the public, to other registered trade-mark owners, and to the petitioner of the questions involved here, we earnestly submit that this Court should grant the petition and issue a writ of

certiorari to the Eighth Circuit Court of Appeals. Surely, now is the time to set aright the law of the Eighth Circuit, for to wait is to condemn the petitioner to the shackles of the new rules, is to permit time and the new rules to work against the other owners of registered trade-marks, and is to allow the public to become hopelessly confused.

Respectfully submitted,

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St. Louis, Missouri,
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FILED
NOV 8 1940
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November 6, 1940.

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No. 518

ANSWER OF RESPONDENTS TO PETITION FOR WRIT OF CERTIORARI

No reason is apparent to us why the Court should grant the Writ in this case. In spite of Petitioner's intimations to the contrary, the Circuit Court of Appeals decided merely an issue of fact between the parties to this litigation. There are involved no questions of general or public interest.

(NOTE: The footnote references in the quotations are not in the original Opinion but are added by us.)

The Proceedings

The act of which Petitioner (Plaintiff below) complained was the sale at St. Louis by the Walgreen Drug Stores of "glassware including bottles" made by the Corning Glass Works, to which was applied Corning's registered trade-mark "Pyrex."[1] The Corning Glass Works intervened

[1] No. 115,846, March 13, 1917 for "glass" and No. 190,518, October 14, 1924 for "nursing bottles" (Rec. 513, 531).

and assumed the defense. The only act proved was the sale by Walgreen of nursing bottles of Corning's manufacture bearing Corning's "Pyrex" trade mark. It was averred that this was an infringement of Petitioner's registration No. 231,759 of August 23, 1927[2] for the word "Rex" written in script for "prescription bottles made of glass". An interlocutory decree for injunction was issued by the District Court (R-1108) perpetually enjoining Respondents from using "Pyrex" upon "glassware" anywhere in the United States and for an accounting resulting from Corning's use of "Pyrex" on glassware of all descriptions.

The District Court wrote no opinion.

The Circuit Court of Appeals reversed and directed dismissal of the complaint (113 Fed. (2d) 956).

Plaintiff's "Rex" as registered for prescription bottles and Corning's "Pyrex" as used on the alleged infringing article are as follows:

as it appears in Petitioner's Registration

as it appears on the Corning nurser.

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[2] Rec. 69.

The Facts

The Circuit Court of Appeals thus stated the facts as to Corning's use of "Pyrex" (Rec. 1208):

> "The Corning Glass Works had, prior to 1915, perfected a manufacturing process by which it produced a special quality of glass which resists temperature changes and other shocks. The name 'Pyrex' was applied to that glassware in 1915. The word has its origin in the Greek word 'pyr' meaning fire, and the Latin word 'rex', meaning king. Corning had theretofore applied the terms 'Nonex' and 'CRX' to glass of this character as indicative of its non-expansion qualities. Upon the adoption of the trade-mark 'Pyrex,' Corning applied it to many articles of glassware it was manufacturing, including all kinds of cooking utensils. It began the manufacture of laboratory equipment made of its heat-resisting glass and applied to that equipment the mark 'Pyrex.' Later, it manufactured electrical glass, such as insulators, industrial ware, such as pulleys for machinery, vacuum bottles, and many other articles of general as well as technical use. It manufactured a two-hundred inch telescope mirror disc for the California Observatory from its Pyrex glass and applied the name to the product. It manufactured the Mount Palomar two hundred-inch telescope mirror from its glass and applied the mark 'Pyrex' to that product. It has spent millions of dollars[3] advertising products of its manufacture from Pyrex glass as having peculiar heat-resisting qualities and characteristics not possessed by ordinary glass. The name 'Pyrex,' subsequent to 1915 and prior to 1922, became known throughout the country almost as a household word indicative of the products made of a particular kind of heat-resisting glass.[4] The name 'Pyrex' has been

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[3] The Record (748) shows an expenditure of $2,752,803.99 to 1930 when Petitioner first notified Corning as to the alleged infringement (Rec. 73, 111).

[4] Sales during the same time amounted to $35,930,093 (Rec. 741).

so thoroughly established as describing a heat-resisting glass that the late edition of the Merriam-Webster International Dictionary, Unabridged, contains the following definition:

> "'Py' rex (pi' reks) (Gr. Pyr. fire—L. rex king). A trade-mark applied to a variety of glasses and glassware usually resistant to heat, chemicals or electricity; hence (sometimes not cap.), glass or glassware bearing this trade-mark,—py' rex, adj.'

> "Corning has never at any time manufactured or sold prescription bottles, but in 1922, it began the manufacture of a nursing bottle made for the purpose of permitting the heating of infants' food in the bottle without injury to the container. It applied the mark 'Pyrex' to that product. In 1924, it obtained a certificate of registration of the trade-mark 'Pyrex' applied to nursing bottles. It manufactured and sold many thousands of these bottles between the years 1922 and 1928, the bottles all being labeled 'Pyrex Nursing Bottle,' and sold as such."

The history of plaintiff's use of "Rex" is thus stated by the Court of Appeals (Rec. 1208):

> "The plaintiff has never manufactured any glassware other than bottles. For many years subsequent to January 2, 1896 it applied the trade mark 'Rex' only to prescription bottles sold to druggists for that specific use."

It is apparent that "Rex" in script, as it appears in Petitioner's registration, is only a slight modification of the commonly used symbol "Rx", meaning prescription, and that a prescription bottle is nothing but a container used by the druggist to hold medicine sold by him.[5] It is a one-use article and nothing more, being in this respect like a bag to hold groceries. The bottle is sold by the wholesale druggist, or jobber, to the dispensing druggist. This sale ends the trade mark use of any maker's mark upon

[5] Record, page 959.

the bottle because it is not sold by the druggist as a bottle.[6] Even if the bottle carries a trade mark that fact means nothing to the purchaser of the medicine; it does not indicate to him the maker of the bottle; he does not care who made it. He is not interested in its trade name. He uses the bottle but once and knows it only as a container for its contents, and not as a separate commodity.

The Court thus continues its discussion of the "Rex" history:

> "For a short time prior to 1919, the mark 'Rex' was applied to liquor bottles, but this use was discontinued in 1919 and has never been resumed. At the time plaintiff procured its certificate of registration for the trade-mark 'Rex', October 23, 1900,[7] it stated that, 'The class of merchandise to which this trade-mark is appropriated is bottles, and the particular description of goods comprised in said class upon which the trade-mark is used is prescription bottles. * * * When it applied to re-register the trade-mark on April 25, 1927, it stated in its application as follows: 'Be it known that Obear-Nester Glass Co., a corporation * * *, has adopted and used the trade-mark shown in the accompanying drawing, for PRESCRIPTION BOTTLES MADE OF GLASS, Class 33, Glassware.' From the date of the first registration of its trade-mark until 1928, with the exception of the application to liquor bottles, plaintiff has never at any time applied the mark 'Rex' to anything other than prescription bottles" (Rec. 1208).
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> * * * * * *
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> "It was not until 1928 that plaintiff applied its trade-mark 'Rex' to nursing bottles. These Rex nursing bottles are not similar to the Pyrex nursing bottles either in material, appearance or price. They are cheap bottles, made of ordinary glass, costing about five cents each, whereas the Pyrex nursing bottles are sold at twenty-five cents.
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> "In 1930, plaintiff extended the use of its trade-mark to a bottle known as a 'utility bottle'. In 1929,

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[6] Record, page 960. See also Record 1217.

[7] Record, page 67.

> it applied the trade-mark 'Rex' to toilet bottles of an indiscriminate character, and in 1931, it applied its trade-mark to a bottle known as the 'Pockiteer Flask', used as a container for liquor. All of these products manufactured by plaintiff were made from ordinary glass" (Rec. 1210).

In addition to its prescription bottles, Petitioner was at an early date also selling nursing bottles. It called them "Round Sterilizers", "Oval Sterilizers", "Bentneck Nursers", and "Baltimore Nursing Bottles". It did not apply "Rex" to them. But in 1928, six years after Corning's "Pyrex" nursing bottles had been widely sold and were known to most people having to do with feeding babies, Petitioner rechristened as "Rex" the same old bottles it had sold up to that time under other names.[8] It never extended its trade mark registration to such bottles.

The nursing bottles thus rechristened "Rex" were never known or called by that name. They are dealt in mostly as "five-cent nursers" and "nickel nursers".[9] "Pyrex" nursing bottles are known for their heat-resisting properties. They are recognized by everybody as a high-grade, comparatively expensive, dependable and scientific utensil and are called for by their name.[10]

The point of Petitioner's attack is that "Pyrex" on nursers is an infringement of the "Rex" mark applied by Petitioner to prescription bottles; that such use causes confusion between "Pyrex" nursers and the nursers which the Petitioner later rechristened "Rex"; and that therefore Petitioner had the right to stop Corning from using "Pyrex" on *anything made of glass.*

The Court of Appeals said (Rec. 1217):

> "The only substantial claim of conflict or confusion arises with reference to a nursing bottle manufactured by Corning from its heat-resisting glass and

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[8] Record, page 45.

[9] Record, page 997.

[10] Record, page 998.

> a nursing bottle manufactured by plaintiff out of ordinary glass, and as to this it should first be observed that plaintiff did not extend its business into this field until 1928, when it first placed its trade-mark 'Rex' upon nursing bottles. Corning, in 1922, put out its Pyrex nursing bottles. These bottles were made of Pyrex glass so that they might be heated without injury, and they were branded the same as the baking ware and scientific apparatus manufactured by Corning. Corning had occupied this field six years prior to the time that Obear-Nester placed its 'Rex' trade-mark upon nursing bottles, and during this time defendant expended large sums of money[11] in advertising its Pyrex nursing bottle."

Petitioner, as Plaintiff in the District Court, based its cause of action exclusively on its registration of "Rex" (in script) No. 231,759, on August 23, 1927, under the Trade-mark Statute (U. S. C. Title 15, Sections 81 and following) as a trade-mark for "prescription bottles made of glass". No common law rights were relied upon, no unfair competition was alleged, there was no charge of fraud, no allegation of deception of purchasers, and no proof of it.

The Findings of the Circuit Court of Appeals.

We have in the foregoing presented the facts of this case mainly by quotations from the Opinion. On the facts thus found the Court held:

> 1. That in view of the recited history of plaintiff's two registrations, namely, those of 1900 and 1927, in the instant case plaintiff's trade mark was registered for prescription bottles only (Rec. 1212) and "Corning has never manufactured prescription bottles or any glassware resembling such bottles"

[11] Corning in the six years between 1922 and 1928 spent $138,595.39 in the advertisement of the "Pyrex" nurser (R. 748) and its sales during that period amounted to over $609,000 (R. 744). Obear-Nester sales of the rechristened "Rex" nursers in the ten years from 1928 to 1937 aggregated less than $19,000 (Rec., pp. 1086, 1087).

(Rec. 1215) and "defendant's mark is not affixed to products of the same descriptive properties" as prescription bottles (Rec. 1217).

2. That in view of the whole picture as above presented "It would be difficult to believe that any confusion would probably or could possibly result from the use of defendant's trade mark on its prescription wares, or that anyone of ordinary intelligence could be deceived by the use of its trade mark, or that any such person might be led to purchase the defendant's goods on the belief that he was purchasing those of the plaintiff" (Rec. 1217).[12]

3. That "Pyrex" is not a colorable imitation of "Rex"; that "it" was adopted in good faith and has neither the sound nor the appearance of "Rex" (Rec. 1217).

4. That in so far as concerns any claim on the part of the plaintiff based upon its use of "Rex" on nursing bottles, "plaintiff entered the field after the defendant had already occupied it and had spent large sums of money in advertising its "Pyrex" nursing bottle, thereby acquiring a prior right to the use of the trade mark on this product" (Rec. 1218) and that for this reason the registration of "Rex" for prescription bottles did not preserve for all time for the plaintiff a monopoly on all other bottles of whatever description or quality or upon all glassware (Rec. 1219).

Petitioner's attempt to conjure from this situation novel questions of trade-mark law and its misapplication of accepted principles to the present case seems to us futile in view of the manifest soundness of the conclusions reached by the Circuit Court of Appeals. No new law is laid down

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[12] On page 5 of its petition Petitioner states that the record contains evidence of direct confusion. This is not true, and the record citations given by the Petitioner do not support the statements.

and the decision is in accord with the decisions of this Court and other Circuit Courts of Appeal. There was no dissent in the Court of Appeals, which, in the final analysis, passed only upon a question of fact—Was the mark used by Respondents on Corning's goods calculated to represent them as coming from Petitioner? This question of fact the Court decided in the negative.

In case of fact, precedents dealing with different facts are not decisive or even helpful.

In *Johnston* v. *Orr-Ewing,* L. R. 7—A. C. 219, Lord Watson said:

> "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?"

Lord Blackburn:

> "The question to be determined is a question of fact."

The fact here is that there is no deception. There is no formula or tape line as Petitioner suggests which applies to all cases. It is not as simple as that. As Mr. Justice Sutherland observed in *American Steel Foundries* v. *Robertson,* 269 U. S. 372, 381:

> "Judicial interference will depend upon the facts proved and found in each case."

We would assume that this Court would not be disposed to grant a Writ merely to review facts included in a record the size of this one.

Before taking up the several points of Petitioner's argument we call attention to a misstatement found on page 13 of Petitioner's brief. On that page, after referring to the amendment to the original draft opinion made by the Court on the petition of Corning, the brief says:

> "Petitioner was not given a hearing on this amendment."

And in the footnote on that page it is said:

> "The procedure by which the changes were made was substantially ex parte."

The changes made in no way affected any point on which the petition for certiorari is based, but we, however, feel that we should point out that these statements in Petitioner's brief are wholly incorrect. The change was suggested in a printed petition filed by Corning to modify the Opinion (Rec. 1221). This petition was duly served on the Petitioner here and to it the Petitioner here filed a printed memorandum in opposition (Rec. 1249). Thus, the Petitioner here had a hearing and the proceedings in this respect were not ex parte.

Petitioner's Point 1.

Petitioner's discussion of this point is as though the Court of Appeals' decision was one generally applicable and disregards the facts that render this case unique.

As before pointed out, Petitioner in its 1900 registration asserted its right to Rex for the *class* of bottles and particularly for prescription bottles. In taking out its 1920 registration, in suit, Petitioner limited its asserted right to prescription bottles, omitting any claim to bottles as a broad class.

The Court had this state of facts clearly in mind in referring to disclaimers in trade marks as being analogous to disclaimers in respect to patent claims. The Court said (Rec. 1208):

> "At the time plaintiff procured its certificate of registration for the trade-mark 'Rex,' October 23, 1900, it stated that the class of merchandise to which this trade-mark is appropriated is bottles, and the particular description of goods comprised in said class upon which the trade-mark is used is prescription bottles. * * * When it applied to re-register the trade-mark on April 25, 1927, it stated in its application as follows: 'Be it known that Obear-Nester

> Glass Co., a corporation * * *, has adopted and used the trade-mark shown in the accompanying drawing, for PRESCRIPTION BOTTLES MADE OF GLASS, Class 33, Glassware.' "

Under Rule 22-b of the Patent Office, printed on page 19 of Petitioner's brief, the Petitioner here could, in 1927, have claimed Rex as applied to bottles as a class and could have specified prescription bottles as the particular goods to which the mark was applied. To state it differently, Petitioner in 1927 could have used the exact words for defining the scope of its registration as it used in its 1900 registration.

Petitioner's Point 2.

In support of this point, Petitioner cites several decisions, acknowledging, however, that this Court has not passed on the question involved. However, none of the cases cited involves the particular state of facts pointed out in the quotation made under Point 1 from the decision of the Circuit Court of Appeals in deciding this case.

Petitioner asserts that the goods of the parties are "merchandise of substantially the same descriptive properties" as that curiously vague term is used in the Statute.

After a good deal of indecision, the Courts now construe this language to mean that goods are of substantially the same descriptive properties if the use upon them of a common mark would represent that they had a common origin and as a consequence result in deception. They arrive at this sensible conclusion in consideration of the fact that the purpose of the trademark statute is to suppress deception as to the commercial origin of goods. Where, as here, no deception in fact results from the use by Respondents of the mark complained of, the question of the descriptive properties of the goods is irrelevant.

Petitioner's Point 3.

This is based on the theory that the doctrine of expansion in business is applicable to a suit on a registered trade mark and that under that doctrine the registered trade mark covers not only the use of the mark on merchandise of the same descriptive properties as those set forth in the registration but also covers and authorizes the owner of a registered trade mark to stop its use not only upon articles to which he has applied it "but upon such other goods as might naturally be supposed to come from him", this being the scope afforded under this doctrine in *L. E. Waterman Co.* v. *Gordon,* 72 Fed. (2d) 272. On this theory in the *Waterman* case the Court extended the protection of "Waterman," used by the plaintiff on fountain pens, to razor blades. Likewise on this theory, *Eastman Co.* v. *Kodak Cycle Corp.,* 15 R. P. C. 105, extended the coverage of "Kodak" from cameras to bicycles, and *Wall* v. *Rolls Royce,* 4 Fed. (2d) 333, extended the coverage of "Rolls Royce" from automobiles to radio tubes.

Petitioner in seeking improperly to apply the rule of coverage of unfair competition cases to this statutory proceeding is confessing that it cannot urge that the goods of which it complains are goods which, in the wording of the Statute, "are of the same descriptive properties" and that it has no standing in this Court in a suit based on the Statute. However, the Court below did not predicate its decision on a holding that the doctrine applicable to "expansion in business" was barred by the nature of this proceeding alone, but on the holding that such doctrine is inapplicable to the facts of this case. Petitioner does not assert that the Court below erred in its finding of the facts.

The Court said (Rec. 1219):

> "A somewhat similar contention was urged in *Emerson Electric Manufacturing Company* v. *Emerson Radio & Phonograph Corporation,* 2 Cir., 105 F. 2d 908. In that case, the Emerson Electric Manufacturing Com-

pany brought suit for infringement of its trade-mark and for unfair competition against the Emerson Radio & Phonograph Corporation. In the course of the opinion, the court holding that when one acts innocently and is not chargeable with notice, he may demand that the court weigh his interest as it has developed at the time the suit is brought, said:

> 'There is a great difference between such a case and one in which the second merchant invades a market which the first is already exploiting. Whether even then he is to be charged with notice of the first's prior user we lay aside; but certainly the defendants at bar should not be charged with notice that the plaintiff would begin to sell radios, or that the public would assume that radios sold by them came from the plaintiff. If the plaintiff proposed to keep the radio market as an unused preserve, it was bound to protect it against invaders by affirmative action; it could not impose upon them the duty of divining its own purposes or possible mistakes of the public.'
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> "So here, the defendant could not certainly, in face of the declared purpose of plaintiff to limit its trade-mark 'Rex' to prescription bottles, and its conduct in limiting its products to such bottles, have anticipated that it would begin to manufacture and sell nursing bottles."

Certiorari was refused by this Court in *Emerson* v. *Emerson* on December 4, 1939 (308 U. S. 616). The *Emerson* case is a recent decision by the Circuit Court of Appeals of the Second Circuit—the same court which earlier decided the *Aunt Jemima*[13] and *Landers, Frary & Clark*[14] cases cited by Petitioner. In the *Emerson* case the Court followed its own previous decision in *Gold Dust* v. *Hoffen-*

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[13] *Aunt Jemima Mills Co.* v. *Rigney & Co.*, 247 F. 407 (C. C. A. 2).

[14] *Landers, Frary & Clark Co.* v. *Universal Cooler Corp.*, 85 F. (2d) 46 (C. C. A. 2).

berg et al., 87 Fed. (2d) 451, which was subsequent to the *Aunt Jemima* and *Landers* cases relied on by Petitioner.

The petitioner seeks to differentiate (page 29) the *Emerson* case on the ground that that case "related solely to a matter of notice", presumably meaning lack of notice to defendant. In the present case there was no notice to the Respondent of the claim now advanced until it had been using its "Pyrex" trade mark for fifteen years.

Petitioner's Point 4.

That the Circuit Court of Appeals was fully conscious of Rule 52-A of the Rules of Civil Procedure is shown by the quotation from the *Esso* case[15] printed on page 32 of Petitioner's brief. Nevertheless, they reversed the District Court on the question of identity of goods and on the question of similarity between "Rex" and "Pyrex". It must, therefore, be assumed that the Court found that "a serious mistake had been made in the consideration of the evidence or an obvious error had been committed in the application of the law." The Court found these facts in carefully considering the record, and after summarizing the findings of fact and conclusions of law, as made by the District Court, said:

> "The following facts are established either by admissions or by undisputed testimony, and although not embodied in the court's findings, we think them material to the issues in this suit" (Rec. 1208).

The decision of the District Court was predicated on the erroneous legal theory on which the Complaint was based. The Circuit Court of Appeals very properly held that this theory was unsound, and said that there were certain facts not embodied in the Trial Court's findings which were established either by admissions or undisputed testimony, and thereupon proceeded to make additional find-

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[15] *Esso, Inc.* v. *Standard Oil Co.*, (C. C. A. 8) 98 F. (2d) 1.

ings—substantially that Petitioner had never manufactured any glassware except bottles, that Respondent prior to 1915 had perfected a manufacturing process by which it produced a special quality of glass and applied the trademark "Pyrex" to articles made from this glass, that there was no deception or confusion of goods, and hence no infringement in fact, with the necessary corollary that the statute does not create a cause of action where none existed at common law.

Petitioner's Point 5.

This is a reiteration of points 1 and 2, with special emphasis on the alleged great public interest of the decision below and the need of correcting the supposed error in it on the pretended ground that the protection afforded by several hundred thousand registrations, is imperilled by that decision. This is not so; for as we have pointed out, there never has been, and probably never will be, a case like this where the registrant on registering his trade mark voluntarily limits the scope of the description of the goods set out in it, and then asserts that as he might have broadened the description of goods, but did not, the world is put on notice by what might have been done but was not. In short, that the registration *is notice in favor of the registrant of what he fails to claim.* The exact reverse is the case, as the Court below properly held. The situation, as the Court correctly pointed out, is like that of a patentee who describes and claims his invention in his patent. He is confined within its four corners. Petitioner bottomed its case on the statute, and must, as the Circuit Court of Appeals decided, rest its case on the statute.

Here the Respondent has used its "Pyrex" trade-mark notoriously and extensively advertised[16] it for twenty-five years so that probably it is one of the best known and most

[16] Samples of Respondent's advertisements are found on pages 779-800, and 1129-1174 of the Record.

highly esteemed trade-marks in the world representing public confidence and a good will of enormous value. The Circuit Court of Appeals naturally felt that to stop this use, destroy the value and require all the profits of the business to be turned over to a prior user of the word "Rex" on prescription bottles would be a plain perversion of every principle of trade-mark law.

The reasons for the Writ alleged in the Petition seem to us to be unreal and without substance.

We ask that the Petition be denied.

Respectfully submitted,

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November 6, 1940.